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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,656	02/13/2002	Hubert Baumgart	IN-5554	7707

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EXAMINER

SERGEANT, RABON A

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 12/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/049,656

Applicant(s)

BAUMGART ET AL.

Examiner

Rabon Sergeant

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --.

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21,23,25-37,42 and 43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21,23,25-37,42 and 43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Objection is made to applicants' amendment of September 20, 2005, because the faxed copy received is unclear with respect to the text in general and especially the text of the claims that is to be deleted. The "strikethrough" lines or notations are not readily discernible.
2. Claims 30 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants have claimed that their composition is "curable"; therefore, it is unclear how to interpret the limitations of claims 30 and 34. With respect to claim 30, the requirements that the composition be both "curable" and "crosslinked" are contradictory. With respect to the structures of claim 34, it is unclear how to reconcile the requirements that the compositions are both "curable" and in the claimed form. For example, it is unclear what constitutes a curable molding, fiber or film.

3. Claims 21, 23, 25-37, 42, and 43 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicants have failed adequately define exactly what is meant or what features are encompassed by "curable". It is unclear what definitive requirements are set forth by the language. For example, it is unclear if "curable" is limited to requiring only the presence of chemical moieties that will cause the composition to "chemically cure". It is not seen that

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applicants' cited disclosure clarifies the language. This issue must be resolved, since applicants have specifically relied upon the term to distinguish the claims from the prior art.

4. Claims 21, 23, 25-37, 42, and 43 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicants have failed to provide adequate enablement for all mechanisms that fall within the scope of the claimed composition being "curable". One of ordinary skill in the art could not practice the invention without having to resort to undue experimentation. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

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evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 21, 27-31, and 33-37 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 00/15725.

The reference discloses polymeric coating compositions wherein diethyloctanediol is disclosed as a reactant. See page 15, line 10. Though the reference fails to disclose the particular isomer used, the claims are considered to be met despite applicants' argument, because the claims encompass all position isomers. The examiner has considered applicants' arguments; however, the rejection has been maintained for the following reasons. Firstly, the position is taken that the reference discloses the use of diethyloctanediol as a monomer in the production of a polymeric varnish; therefore, one would have recognized that polymeric compositions containing the argued repeating units are present, since the polymerization of the argued monomers will yield the argued repeating units. Secondly, without further definition, no definitive meaning can be ascribed to the "curable" language of the claims that justifies removal of the prior art rejection. Since applicants have failed to clearly define what is meant or encompassed by the language, it cannot be determined if the language patentably distinguishes the instant claims from the prior art.

7. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

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8. Claims 21, 23, 25-37, 42, and 43 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 19826715.

The reference discloses coating compositions derived from 2,4-diethyloctane-1,5-diol. See abstract. Despite applicants' arguments, the abstract clearly discloses the curing of a polymerizable composition comprising the compound derived from 2,4-diethyloctane-1,5-diol, and the position is taken that the resulting polymer satisfies the "two or more monomer units" limitation. Despite applicants' remarks, the reference allows for polymerizing the argued diethyloctanediol derivative; therefore, the resulting polymer contains the argued monomer units. As aforementioned, without further definition, no definitive meaning can be ascribed to the "curable" language of the claims that justifies removal of the prior art rejection. Since applicants have failed to clearly define what is meant or encompassed by the language, it cannot be determined if the language patentably distinguishes the instant claims from the prior art.

9. Claims 21 and 27-31 are rejected under 35 U.S.C. 102(b) as being anticipated by GB 778924.

The reference discloses polymeric compounds produced from 3,6-diethyl-1,8-octanediol. See page 4, lines 55 and 75-85. Despite applicants' remarks, the position is taken that the skilled artisan would immediately envisage the use of the saturated diethyloctanediol within the disclosed polymers at page 4, lines 75-85. Furthermore, the position is taken in view of a polymer's definition requiring repeating units that the disclosed polymers inherently satisfy the argued "two or more monomer units" language. With respect to applicants' arguments, to the extent that the meaning of "curable" is understood, the position is taken that the disclosed "drying oils" satisfy applicants' requirement that the composition be "curable" and contain the

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argued units. Furthermore, aside from the aforementioned position, the position is taken that “curable” has not been adequately defined, so as to be able to concretely determine exactly what limitations are conveyed by the language. In the absence of further definition, the presence of the language does not justify removal of the rejection.

10. Claims 21, 23, 25-37, 42, and 43 are rejected under 35 U.S.C. 102(a) as being anticipated by EP 940459.

The reference discloses coating and adhesive compositions derived from various diethyloctanediols, including 2,4-diethyloctane-1,5-diol. See page 2 and claims. As aforementioned, without further definition, no definitive meaning can be ascribed to the “curable” language of the claims that justifies removal of the prior art rejection. Since applicants have failed to clearly define what is meant or encompassed by the language, it cannot be determined if the language patentably distinguishes the instant claims from the prior art.

11. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

12. Within polymeric systems, it is uncommon for weight average molecular weights and number average molecular weights to be equivalent; therefore, it is common for the polydispersity of such systems to exceed unity, often by a considerable margin; therefore, with respect to the rejections set forth within paragraphs 5-10, though the relied upon references fail to specifically recite applicants’ claimed polydispersity range, the position is taken in view of the breadth of the claimed range and the preceding rationale that the claimed polydispersity range is

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inherently met by references. Applicants have not established that the prior art compositions possess polydispersity values outside of the claimed range.

13. Claims 21, 23, 25-37, 42, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 00/15725 or DE 19826715 or GB 778924 or EP 940459.

As aforementioned, the references disclose the use of diethyloctanediol in the production of polymers, suitable for use as coatings and adhesives.

14. Though the references fail to disclose each of applicants' claimed isomers, the position is taken that it would have been obvious to utilize any isomer of diethyloctanediol in the production of polymers, based upon the teachings of the references. The basis for this position resides with the expectation that compounds that have a close structural similarity possess similar properties. *In re Wilder*, 563 F.2d 457, 195 USPQ 426 (CCPA 1977). *In re May*, 574 F.2d 1082, 197 USPQ 601 (CCPA 1978). This position is bolstered by the fact that the utility and function of the argued compounds within polymerization reactions were well understood; therefore, the skilled artisan would have had a reasonable expectation of success in substituting one compound for another.

15. Applicants' response has been considered; however, it is not seen that the response adequately rebuts the position that compounds having close structural similarities are expected to possess similar properties and, as a result, are obvious in view of each other. Furthermore, applicants have based their response on the limitation that the compositions containing the argued units are "curable"; however, the position is taken that the language has not been adequately defined; therefore, no meaningful limitation can properly be ascribed to the language. In the absence of such definition, it cannot be determined if the language patentably

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distinguishes the claims from the prior art. The examiner's position with respect to polydispersity has been set forth within paragraph 12.

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication should be directed to R. Sargent at telephone number (571) 272-1079.


RABON SERGENT
PRIMARY EXAMINER

R. Sargent
November 28, 2005